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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,055	12/11/2001	Andrew J. Fish	10559-627001/P11061	4855
7590 12/17/2004			EXAMINER	
JONI D. STUTMAN-HORN C/O BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP 12400 WILSHIRE BOULEVARD, SEVENTH FLOOR LOS ANGELES, CA 90025			HENRY, MATTHEW ALLAN	
			ART UNIT	PAPER NUMBER
			2116	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/016,055	Applicant(s) FISH ET AL. 	
	Examiner Matthew A. Henry	Art Unit 2116	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 0201.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-14 is/are allowed.
- 6) ☒ Claim(s) 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/11/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. **The drawings are objected to under 37 CFR 1.83(a) because they fail to show the “interactions of various components of an EFI specification-compliant system” in Figure 2B as described in Paragraph 36, Lines 2-3 in the specification.** Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The attempt to incorporate subject matter into this application by reference to <http://acpi-info/index-html>, <http://developer-intel-com/ial/WfM/design/BIBLIOG.HTM> and http://developer-intel-com/technology/efi/main_specification.htm are improper because they are embedded hyperlinks. Applicant is required to delete the embedded hyperlinks. See MPEP § 608.01.

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Method of Switching from a Legacy-Free Boot System to a Legacy Boot System.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. **Claim 15 is rejected under 35 U.S.C. 102(a) as being anticipated by *Legacy Technology Transitions*.**

In regards to Claim 15, Legacy Technology Transitions discloses:

A data processing system (Page 11, Column 1, Paragraph 4, Lines 1-2) comprising:
means for processing instructions and data (Page 11, Column 1, Paragraph 4, Lines 1-2);
and

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means for separating a legacy-free boot path from a legacy boot path (Figures 12 and 13; Page 11, Column 2, Paragraph 4, Lines 1-4) such that the legacy boot path comprises an encapsulated boot process (Page 11, Column 2, Paragraph 5, Lines 1-4).

Claim Rejections - 35 USC § 103

6. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Legacy Technology Transitions* in view of Patel.

In regards to Claim 16, Legacy Technology Transitions discloses:

The ISA bus and ISA-based input/output ports are legacy firmware (Page 1, Column 1, Paragraph 1, Lines 4-8).

Patel teaches:

the legacy boot path comprises legacy firmware from a legacy option read only memory (Column 6, Lines 41-46).

Patel provides evidence describing the specifics of the ISA bus and related input/output devices that are disclosed as legacy technology by *Legacy Technology Transitions*. It would have been obvious to a person of ordinary skill in the art to consider the ISA devices bearing option ROMs described by Patel as a type of the legacy ISA input/output devices described by *Legacy Technology Transitions*.

In regards to Claim 17, Patel further teaches:

the legacy option read only memory comprises a part of a plug-in device (Column 6, Lines 41-46).

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In regards to Claim 18, Legacy Technology Transitions discloses:

the legacy option read only memory comprises a part of a legacy platform (Page 1, Column 2, Paragraph 2, Lines 4-5; ISA is considered a legacy platform).

Allowable Subject Matter

7. **Claims 1-14 are allowed.**

8. The following is an examiner's statement of reasons for allowance:

In regards to Claims 1, 7 and 11,

The prior art fails to disclose or suggest a motivation for defining a boot process that entails the steps of loading legacy-free drivers, terminating the loading process based upon a legacy boot option and loading legacy free firmware. Therefore it would not have been obvious at the time of invention to a person of ordinary skill in the art to modify current boot processes to include the steps described in the claims above.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


LYNNE H. BROWNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600 2100